

GERD SCHMITZ ET AL.  
USSN 09/786,635

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Applicants reserve the right to prosecute the subject matter of the non-elected claims in a divisional application, if such subject matter is not ultimately granted here.

At the outset, Applicants point out Group III comprising claim 9 is directed to a method of using a polypeptide, rather than a method for identification of modulators as the Examiner alleges.

Claims 1-13 are pending. Claim 9 has been amended to place it in better format prior to substantive examination. New claim 13 is added. It is believed that no new matter has been added.

Regarding the traversal, the basis for the Examiner's restriction is under PCT Rule 13.1 for lack of Unity of Invention. The Examiner alleges that Groups I, II, and IV and Groups III and V do not form a single inventive concept within Rule 13.2.

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According to PCT Administrative Rules (Annex B, Part I) "unity of invention exists only when there is a technical relationship among the claimed inventions involving one or more of the *same or corresponding* special technical features. The expression "special technical features" is defined in Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art.

In the instant case, the special technical feature shared by all the claims in Groups I to V is the polynucleotide. The polynucleotide either (a) encodes the polypeptide of SEQ ID No. 2 or (b) hybridizes to the polypeptide (a) and has at least 20% homology thereto, or (c) is a fragment of (a) or (b). Because the claims all share this special technical feature, unity of invention exists, and restriction is improper. Accordingly, Applicants respectfully traverse the restriction between Groups I to V, and request the withdrawal of the requirement.

In the event the Examiner maintains the restriction requirement, Applicants submit that Groups III and V should be examined together with Group I. In this regard, Applicants would call the Examiner's attention to the Commissioner's Notice published in the Official Gazette on March 26, 1996, at 1184 OG 86. According to that notice:

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"[A]pplicant may be called upon under 35 U.S.C. § 121 to elect claims to either the product or the process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from and otherwise includes all the limitations of an allowed product claim."

Applicants presume that the Examiner is proceeding in accordance with this notice, and that Groups III and V will be rejoined and examined in the event that Group I is found to be allowable. If not, then Applicants would appreciate an explanation from the Examiner of why this notice is not applicable.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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